

### **REMARKS**

This responds to the Office Action mailed on August 4, 2008.

Claims 1, 8, 10-11, 20-23, 25 and 28 are amended, claims 2 and 12-18, have been previously canceled, and claims 31-35 are added; as a result, claims 1, 3-11 and 19-35 are now pending in this application. The amendments to the claims provide antecedent basis for terms used in new claims 31-35, correct minor typographical errors, and provide consistent terminology. The amendments are not in response to an art based rejection.

#### **§112 Rejection of the Claims**

Claims 25-27 were rejected under 35 U.S.C. § 112, first paragraph, as lacking adequate description or enablement. In particular, the Office Action stated that “the specification merely mention plurality of types of measurements such as latency and throughput, however the specification does not disclose types of throughput speed.” Applicant respectfully traverses these grounds for rejection. As described in MPEP § 2164 et seq., the following represents the *prima facie* case that the Examiner must provide in order to maintain a rejection of nonenablement with respect to the disclosure of a patent application under 35 U.S.C. § 112, first paragraph:

1. a rational basis as to
  - a. why the disclosure does not teach, or
  - b. why to doubt the objective truth of the statements in the disclosure that purport to teach;
2. the manner and process of making and using the invention;
3. that correspond in scope to the claimed invention;
4. to one of ordinary skill in the pertinent technology;
5. without undue experimentation; and
6. dealing with subject matter that would not already be known to the skilled person as of the filing date of the application.

Because the Office Action has not included evidence supporting each of these elements, the Office Action has not made out a *prima facie* case for nonenablement under 35 U.S.C. § 112, first paragraph.

Furthermore, Applicant respectfully submits that the specification does provide

enablement commensurate with the scope of claims 25-27 for at least the following reasons. Applicant's specification at page 9, lines 13-30 describe measuring speed and selecting a download source having the fastest throughput speed. Further, the specification at page 11, lines 27 to page 12, line 3 describes latency as one form of throughput speed. Still further, the specification, at page 13, lines 3-4 states that in one embodiment, download speed may be used as a measurement of throughput speed. In view of the above, various portions of the specification describe the use of throughput speed. These portions of the figures and specification, among others, enable a person of ordinary skill in the art to make and use the invention commensurate with the scope of claims 25-27.

### §103 Rejection of the Claims

Claims 1, 3-6, 8-10, 19, and 25-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Emens et al. (U.S. Patent No. 6,606,643; hereinafter "Emens") in view of Myers et al. (U.S. Publication No. 2003/0079005; hereinafter "Myers"). The determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on factual evidence. *See Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1336-37 (Fed.Cir. 2005). The legal conclusion that a claim is obvious within § 103(a) depends on at least four underlying factual issues set forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966). The underlying factual issues set forth in *Graham* are as follows: (1) the scope and content of the prior art; (2) differences between the prior art and the claims at issue; (3) the level of ordinary skill in the pertinent art; and (4) evaluation of any relevant secondary considerations.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir.1988). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested, by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) ; M.P.E.P. § 2143.03. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) ; M.P.E.P. § 2143.03. As part of establishing a *prima facie* case of obviousness, the Examiner's analysis must show that some objective teaching in the prior art or that knowledge

generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.* To facilitate review, this analysis should be made explicit. *KSR Int'l v. Teleflex Inc., et al.*, 127 S.Ct. 1727; 167 L.Ed 2d 705; 82 USPQ2d 1385 (2007) (citing *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006)). Applicant respectfully traverses the rejection because the claims recite elements not found in the combination of Emens and Myers.

For example, claim 1 as amended recites that “the type of empirical measurement is selected according to a comparison of a size of data to be obtained from at least one of a plurality of sources with a threshold size.” Claims 8, 25 and 28 as amended recite similar language. The Office Action correctly states in the rejection of claim 1 that Emens “did not teach selecting a type of empirical measurement according to a size of data to be obtained.” However, the Office Action goes on to state that Myers, at paragraph [0058] teaches “selecting a type of empirical measurement ( e.g., throughput) of performance from a plurality of types of empirical measurement (e.g., throughput, latency, etc.), wherein the type of empirical measurement is selected according to a size of data to be obtained from at least one of a plurality of sources ([0058]) (e.g., large files that are greater than 1MB).” Applicant respectfully disagrees with this interpretation of Myers. The cited section of Myers merely states that “many file-sharing applications deal with large files that are greater than 1 MB” and that “high-throughput paths are beneficial to file sharing applications because those files are relatively large and large amounts of data may be moved through high-throughput paths quickly.” In other words, Myers is merely stating that large files benefit from high-throughput paths. In fact, Myers discloses at paragraph [0064] that:

The present network and method of using a network selects the most appropriate route for each application or application type by matching data to the most appropriate path to improve the routing of that data as it is sent through the network according to particular requirements of the application. (emphasis added)

Thus Myers discloses a system in which the application or application type is used to determine routing metrics. This is consistent with paragraph [0058] because certain applications may use files that tend to be large. However, it is clear that neither the cited section of Myers nor any other section of Myers teaches or suggests using a comparison of a data size with a threshold size

to determine a download source. Rather, Myers uses an application or application type, not file size, to determine routing metrics. As a result, independent claims 1, 8, 25 and 28 recite elements not found in the combination of Emens and Myers. Thus there are patentable differences between the cited art and the claims at issue. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 1, 8, 25 and 28.

Claims 21-23 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Emens and Myers in view of Andrews et al. (U.S. Publication No. 2002/0038360; hereinafter "Andrews"). Independent claim 21, like claims 1, 8, 25 and 28, recites "selecting a type from a plurality of types of empirical measurement of performance of each of the plurality of sources, the type of empirical measurement selected according to a comparison of a predetermined file size with a predetermined threshold file size." As discussed above, neither Emens nor Myers teach or suggest the recited language. Andrews appears to have been cited for teaching the use of socket connections and TCP/IP handshaking. However, Applicant has reviewed Andrews and can find no teaching or suggestion of selecting a type from a plurality of types of empirical measurement of performance of each of the plurality of sources, the type of empirical measurement selected according to a comparison of a predetermined file size with a predetermined threshold file size. As a result, the combination of Emens, Myers and Andrews fails to teach or suggest each and every element of Applicant's claim 21, thereby providing differences between the cited art and the claims at issue. Thus claim 21 is not obvious in view of the combination of Emens, Myers and Andrews. Applicant respectfully requests reconsideration and the withdrawal of the rejection.

Claims 7, 11, and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Emens and Myers in view of Ramanathan et al. (U.S. Patent No. 5,913,041; hereinafter "Ramanathan").

Claim 24 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Emens, Myers, and Andrews in view of Ramanathan.

With respect to dependent claims 3-7, 9-11, 19-20, 22-24, 26-27, and 29-30, each of these dependent claims depends from a claim that recites selecting the type of empirical measurement according to a comparison of a size of data to be obtained from at least one of a plurality of sources with a threshold size. As discussed above, none of Emens, Myers or Andrews teaches or

suggest such a selection. Further, Applicant has reviewed Ramanathan and can find no teaching or suggestion that the type of empirical measurement is selected according to a comparison of a size of data to be obtained from at least one of a plurality of sources with a threshold size. Accordingly, dependent claims 3-7, 9-11, 19-20, 22-24, 26-27, and 29-30 are believed allowable over any combination of Emens, Myers, Andrews or Ramanathan for at least the reasons discussed above regarding their respective base independent claims 1, 8, 21, 25 and 28. Applicant respectfully requests reconsideration and the withdrawal of the rejections of claims 3-7, 9-11, 19-20, 22-24, 26-27, and 29-30.

*New Claims 31-35*

Claims 31-35 have been added in this response. Support for new claims 31-35 may be found throughout the specification, and at least on page 13, lines 14-22. Applicant respectfully submits that no new matter has been introduced in new claims 31-35.

Claims 31-35 are depend from claims 1, 8, 21, 25 and 28 respectively, and are allowable for at least the reasons discussed above regarding claims 1, 8, 21, 25 and 28. Further, new claims 31-35 are directed to determining a threshold size used in comparisons with actual data sizes based on the bandwidth of a communications network used by a system initiating a download. For example, a system with a relatively small bandwidth may use a smaller threshold size to determine when a file is "big" while a system with a relatively large bandwidth may use a larger value to determine when a file is "big". Applicant has reviewed Emens, Myers, Andrews and Ramanathan and can find no teaching or suggestion of the subject matter of claims 31-35.

**CONCLUSION**

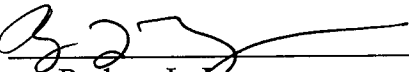
Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's representative at (612) 373-6954 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.  
P.O. Box 2938  
Minneapolis, MN 55402  
(612) 373-6954

Date January 5, 2009

By   
Rodney L. Lacy  
Reg. No. 41,136

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 5th day of January, 2009.

Name Amy Moriarty

Signature 